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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/705,406	11/10/2003	Satoshi Mizutani	20050/0200470-US0	4395
7278	7590	06/28/2005	EXAMINER	
DARBY & DARBY P.C. P. O. BOX 5257 NEW YORK, NY 10150-5257			STEPHENS, JACQUELINE F	
			ART UNIT	PAPER NUMBER
			3761	

DATE MAILED: 06/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/705,406	Applicant(s) MIZUTANI ET AL.	
	Examiner Jacqueline F. Stephens	Art Unit 3761	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |  |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)            |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>6/23/04, 4/19/04</u> | 6) <input checked="" type="checkbox"/> Other: <u>IDS filed 7/8/04, 10/6/04</u>         |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3. Claims 1-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson USPN 4595392.

As to claims 1 and 4, Johnson discloses an interlabial pad having a water-permeable surface side sheet 7, an absorbent body 6, and a back side sheet 8. The interlabial pad comprises a cylindrical portion 3 in which a finger can be inserted for use (Figure 3), wherein the cylindrical portion 3 comprises the sheets 7 and 8 and absorbent body 6 (Figure 3). Johnson does not specifically disclose a pair of fingertip openings, however, Johnson discloses the size of the opening between securement means

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determines whether a single digit or several fingers are used for positioning purposes (col. 2, lines 44-48). It would have been obvious to one having ordinary skill in the art at the time the invention was made to make a pair of openings as opposed to one opening, since it has been held that "constructing a formerly integral structure in various elements involves only routine skill in the art." *Nerwin v. Erlichman*, 168 USPQ 177, 179.

As to claims 2 and 3, Johnson does not specifically disclose the size of the insert opening. However, Johnson discloses the size of the opening between securement means determines whether a single digit or several fingers are used for positioning purposes (col. 2, lines 44-48). Therefore, the general conditions of the claimed invention are present in the prior art. Since where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation, *In re Aller* et al. 105 USPQ 233.

As to claim 5, the sheet body 7 is 100% of a length size of the lateral direction of the pad, which meets the limitation of not less than 80%.

As to claim 6, Johnson does not disclose a pattern or chromatic difference between the sheet body and the opposite side of the pad to the body side. It would have been an obvious matter of design choice to provide a color or pattern to the pad, since applicant has not disclosed that it solves any stated problem or is for any

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particular purpose and it appears that the invention would perform equally well with a uniform pad as taught in Johnson.

As to claims 7 and 8, Johnson discloses a folding guide element 2.

As to claims 9 and 10, see Figures 2 and 3.

As to claims 11-13, the claims As to claim 11, the limitations of absorbing vaginal discharge is directed to an intended use of the article. "Intended use must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963)." If the prior art structure is capable of performing the intended use, then it meets the claim limitations.

Claims 14 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson USPN 4595392 in view of Farris et al. USPN 6131736. Johnson does not disclose a wrapping sheet for covering and enclosing the interlabial product. Farris et al. discloses a packaging device including a wrapping sheet 40 for the benefit of storing the interlabial device until ready for use in such a manner that the user neither touches nor contaminates the surface of the absorbent in handling (Farris col. 5, lines 45-52). It would have been obvious to one having ordinary skill in the art at the time of the


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invention to modify the invention of Johnson to include a packaging device for the benefits taught in Farris.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jacqueline F. Stephens whose telephone number is (571) 272-4937. The examiner can normally be reached on Monday-Friday 9:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Larry Schwartz can be reached on (571) 272-4390. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Jacqueline F Stephens  
Examiner  
Art Unit 3761

June 11, 2005